UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES – GENERAL

Case No.	18 CV-3005 PSG (JPRx)	Date	February 1, 2019
Title	Edgewell Personal Care Brands, LLC et al v. Munchkin, Inc.		

Present: The Honorable	Philip S. Gutierrez, United States District Judge

Wendy Hernandez	Not Reported
Deputy Clerk	Court Reporter
Attorneys Present for Plaintiff(s):	Attorneys Present for Defendant(s):
Not Present	Not Present

Proceedings (In Chambers): **The Court CONSTRUES the Disputed Claim Terms as Stated Herein**

Plaintiffs Edgewell Personal Care Brands, LLC and International Refills Company, Ltd ("Plaintiffs") have sued Defendant Munchkin Inc ("Defendant") for patent infringement. *See Complaint*, Dkt. # 1 ("*Compl.*"); *see also First Amended Complaint*, Dkt. # 36 ("*FAC*"). Specifically, Plaintiffs allege that Defendant makes, uses, sells, offers to sell, and/or imports products that infringe U.S. Patent No. 6,974,029 ("the '029 Patent") and U.S. Patent No. 8,899,420 ("the '420 Patent") (collectively, "Asserted Patents"). *See generally FAC*.

Before the Court are the parties' disputed patent claim terms for claim construction. A Joint Claim Construction and Prehearing Statement reflecting the parties' competing claim construction positions was filed on November 2, 2018. Dkt. # 133 ("*Joint Statement*"). Plaintiffs have filed an opening claim construction brief. Dkt. # 134 ("*Pls.' Opening Br.*"). Defendant has filed a responsive claim construction brief. Dkt. # 135 ("*Def.'s Responsive Br.*"); *see also Declaration of Travis W. McCallon in Support of Def.'s Responsive Br.*, Dkt. # 136 ("*McCallon Decl.*"). Plaintiffs have filed a reply claim construction brief. Dkt. # 138 ("*Pls.' Reply Br.*").

On January 28, 2019, the Court held a hearing on this matter. Having considered the moving papers and the arguments made at the hearing, the Court **CONSTRUES** the disputed claims as stated herein.

I. Background

Plaintiff International Refills Company, Ltd. is the owner of the Asserted Patents and

has granted an exclusive license to Plaintiff Edgewell Personal Care Brands, LLC to practice them. *FAC* ¶¶ 20–21, 30–31. The '029 Patent issued December 13, 2005 and is titled "Casette for Dispensing Pleated Tubing." The '420 Patent issued December 2, 2014 and is titled "Cassette and Apparatus for Packing Disposable Objects Into An Elongated Tube of Flexible Material." The Asserted Patents are not in the same patent family, but both generally relate to an apparatus for collecting materials such as waste within a tube of material. '029 Patent, 1:6–13 ("The present invention pertains to a cassette used for dispensing a pleated tubing contained therein. This type of cassette may be used . . . to collect waste refuse which can be disposed in packages collected in a tubular tubing."); '420 Patent, 1:20–27 ("The present application relates to an apparatus for packaging disposable material or objects into a tube of flexible plastic film material."). Plaintiffs allege that Defendant has infringed certain claims of the '029 and '420 Patents with its sales and offers for sale of certain diaper pail refill cassette products "specifically designed for use with Plaintiff Edgewell's Diaper Genie® System." *FAC* ¶¶ 14, 16.

Additional explanation and discussion of the technology claimed by the Asserted Patents will be provided in the relevant discussion sections of this Order.

II. Legal Standard

A. General Claim Construction Principles

"The purpose of claim construction is to 'determin[e] the meaning and scope of the patent claims asserted to be infringed.'" *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1360 (Fed. Cir. 2008) (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (en banc), *aff'd* 517 U.S. 370 (1996)). The Supreme Court has held that claim construction is a matter of law "exclusively within the province of the court." *Markman,* 517 U.S. at 372. "That is so even where the construction of a term of art has 'evidentiary underpinnings.'" *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 835 (2015) (quoting *Markman*, 517 U.S. at 390).

When construing claim terms, a court must first "look to the words of the claims themselves . . . to define the scope of the patent invention." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Words of the claims are "generally given their ordinary and customary meaning," which is the meaning they "would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing

date of the patent application." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc) (citation omitted).

However, a claim term should be construed "not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." *Id.* at 1313. The specification is "the single best guide to the meaning of a disputed term," and the court should "rely heavily" on it for guidance. *Id.* at 1315, 1317.

Further, a court should consider the patent's prosecution history—the complete record of the proceedings before the United States Patent and Trademark Office ("PTO") and the prior art cited during the patent's examination—because it "provides evidence of how the PTO and the inventor understood the patent." *Id.* at 1317. "[B]ecause the prosecution history represents an ongoing negotiation between the PTO and the applicant, rather than the final product of that negotiation, it often lacks the clarity of the specification and thus is less useful for claim construction purposes." *Id.*

Lastly, although less significant than the intrinsic record, courts may "rely on extrinsic evidence, which 'consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises.'" *Id.* (quoting *Markman*, 52 F.3d at 980). "Extrinsic evidence may be useful to the court, but it is unlikely to result in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence." *Id.* at 1319.

B. Means-Plus-Function Terms

Construction of a patent's claim terms may sometimes also involve construction of "means-plus-function" claim terms. Under 35 U.S.C. § 112, ¶ 6,[1]

[1] The America Invents Act ("AIA") changed the sub-section designations for § 112 from numbered paragraphs to lettered sub-sections. Thus, for instance, 35 U.S.C. § 112(f) applies to patents with an effective filing date after relevant provisions of the AIA went into effect. The language of the section was not otherwise altered by the AIA. Here, the parties agree that a claim phrase in the '029 Patent is subject to means-plus-function claiming. *See Joint Statement* 2. Because the '029 Patent was filed on November 14, 2002, it was filed before the enactment of the AIA and the Court will refer to the older paragraph designation for the relevant sub-section of § 112, *i.e.*, "§ 112, ¶ 6."

> [a]n element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Once it has been determined that a claim term is a means-plus-function term subject to § 112, ¶ 6, courts must engage in a two-step process to construe the term. *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1351 (Fed. Cir. 2015). First, a court must identify the claimed function. *Id.* (citing *Noah Sys., Inc. v. Intuit Inc.,* 675 F.3d 1302, 1311 (Fed. Cir. 2012)). Second, "the court must determine what structure, if any, disclosed in the specification corresponds to the claimed function." *Id.*

III. Discussion

A. Agreed Constructions

The parties have not indicated agreement as to the construction of any claim terms in the Asserted Patents.

B. Disputed Terms

i. '029 Patent Terms

a. "annular cover extending over said housing; said cover having an inner portion . . . and a top portion"[2] (Claim 1) / "said cover"

[2] The parties' Joint Statement listed the "annular cover" term in the '029 Patent as appearing in "Claims 1, 2, 3, 4, 6, and 7." *See Joint Statement* 1. A review of the claim language shows that the term itself only appears in Claim 1. *See* '029 Patent, Claims 1–7. The term further provides antecedent basis for the term "said cover" appearing in Claims 2–5. It seems that the parties intended their claim listing as a way to indicate that the asserted dependent claims that depend from Claim 1 incorporate and include the limitations of Claim 1 by nature of their dependency. The parties only did this for the '029 Patent, not the '420 Patent. Rather than the approach taken for claim designations by the parties for the '029 Patent, the Court solely lists the asserted claims where a relevant claim term actually appears.

(Claims 2, 4)

b. "said top portion including a tear-off outwardly projecting section" (Claim 1) / "said tear-off section" (Claim 1)

Term	Plaintiffs' Proposed Construction	Defendant's Proposed Construction
"annular cover extending over said housing; said cover having an inner portion . . . and a top portion"	Plain and ordinary meaning	"annular cover extending over said housing; said cover having an inner portion . . . and a top portion . . . the portion forming a single or uniform entity"
"said top portion including a tear-off outwardly projecting section"	Plain and ordinary meaning	"said top portion has an outwardly projecting section that is uniform with the remainder of the cover but is configured such that it may be torn away from the remainder of the cover"

The parties' disputes regarding the terms "annular cover extending over said housing; said cover having an inner portion . . . and a top portion" and "said top portion including a tear-off outwardly projecting section" are interrelated and will be considered together. Both of these terms appear in Claim 1 of the '029 Patent, which states,

> 1. A cassette for use in dispensing a pleated tubing comprising:
> an annular body having a generally U shaped cross-section defined by an inner wall, an outer wall and a bottom wall joining a lower part of said inner and outer walls, said walls defining a housing in which the pleated tubing is packed in layered form;
> ***an annular cover extending over said housing; said cover having an inner portion extending downwardly and engaging an upper part of said inner wall of said body and a top portion extending over***

> ***said housing***; ***said top portion including a tear-off outwardly projecting section*** having an outer edge engaging an upper part of said outer wall of said annular body; ***said tear-off section***, when torn-off, leaving a peripheral gap to allow access and passage of said tubing therebetween; said downwardly projecting inner portion having an inclined annular area defining a funnel to assist in sliding said tubing when pulled through a central core defined by said inner wall of said body; and
>
> cooperating inter-engagement means on said upper part of said body and on opposite edges of ***said cover*** to lock said cover to said body.

'029 Patent, Claim 1 (emphasis added). For context, Figure 1 of the '029 Patent, provides an example embodiment that the parties appear to agree is covered by Claim 1:

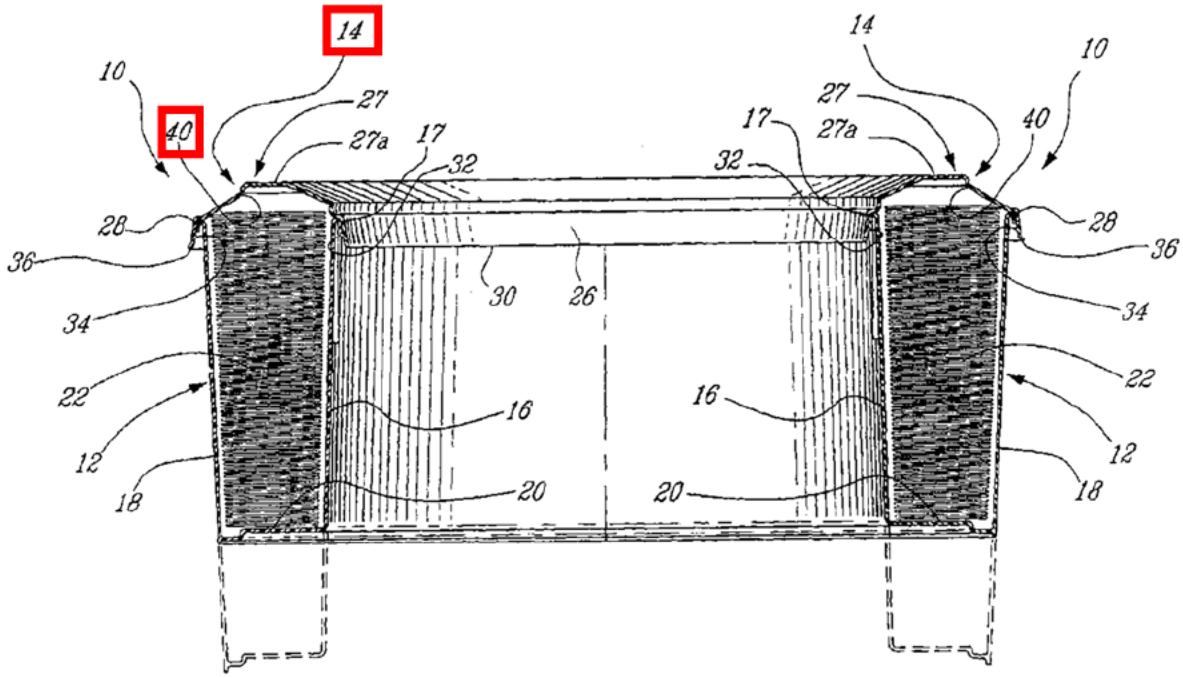


Fig. 1

'029 Patent, FIG. 1 (annotations added). "Part **14** of the cassette consists of an annular cover

that extends over the housing of body **12**." '029 Patent, 2:39–40. The annular cover **14** shown in Figure 1 also includes:

> a top portion **27**, with an outwardly projecting section **28**, that extends over the housing of the annular body. The top portion **27** is formed of a flat area **27***a* and a funnel shaped inner area **27***b* . . . The outwardly projecting section **28** has an area **40** of reduced section connecting it to the top area **27***a* to weaken the material and allow it to be torn-off.

Id. 2:42–61. Figure 2 of the '029 Patent shows the same exemplary embodiment in use "with the tear-off section [**40**] removed." *Id.* 2:20–21.

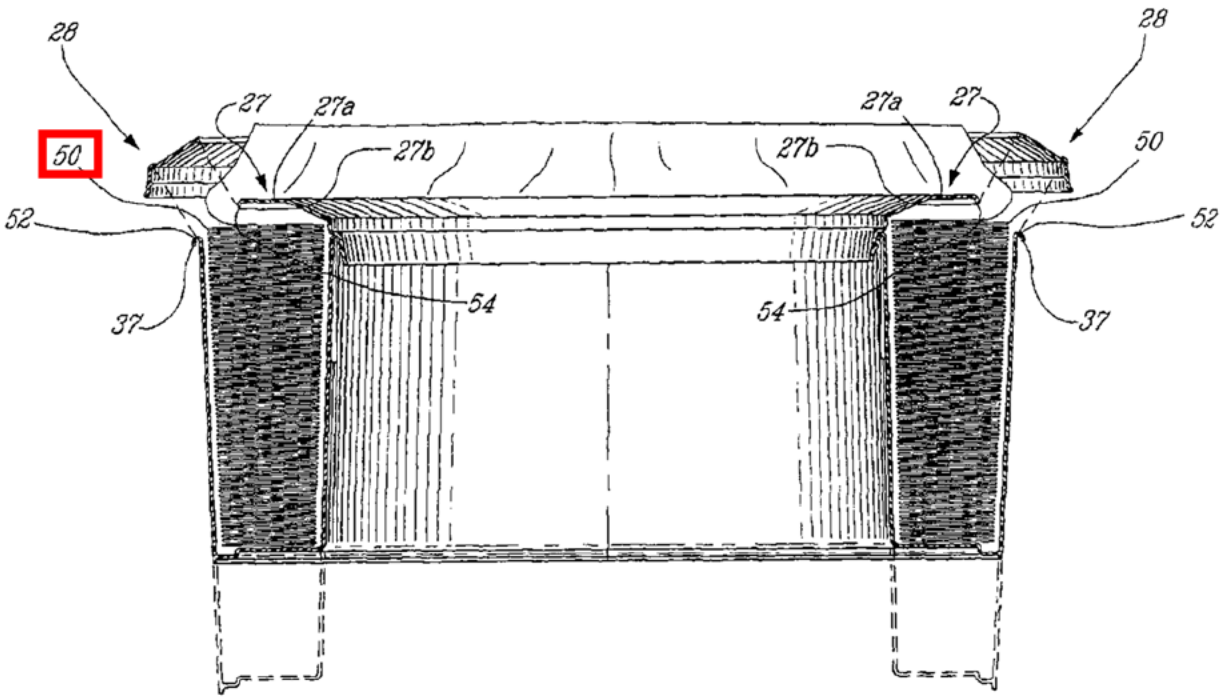


Fig. 2

'029 Patent, FIG. 2 (annotation added). Figure 2 appears to show outwardly projecting section **28** floating up and behind the rest of the device (perhaps to show where/how it was torn off). With the tear-off section **40** (as a part of **28**) removed, a gap **50** appears that allows the tubing stored inside the annular body (*see* label **22** in Figure 1) to be pulled up out of the annular body,

then down through the central core of the device. *Id.* 2:57–3:3; *see also* FIG. 4 (depicting a different embodiment, but showing the movement of the tubing up and around the annular cover).

The key dispute between the parties regarding the "annular cover . . ." and "tear-off outwardly projecting section" terms is apparently whether the "annular cover" must be a single structure or whether it can be comprised of separate and/or distinct structures.

Although Defendant's Responsive Brief shows that its concern centers around its belief that the annular cover claimed in the '029 Patent can only be a single structure, *Def.'s Responsive Br.* 4:11–7:8; *see also id.* 9:25–12:2, this is not accurately reflected in Defendant's proposed claim constructions. Instead, Defendant proposes constructions that suggest an annular cover must be a "uniform entity." As Plaintiffs note, the "single or uniform" language in Defendant's proposed constructions is not only ambiguous, but could suggest that all aspects of the annular cover must be the same. *Pls.' Opening Br.* 6:17–8:5; *see id.* at 7:7–8 ("The meaning of 'single' and 'uniform' in this context is unclear and confusing."); *see also Pls. Reply Br.* 3:5–18. Such an interpretation would be inconsistent with the patent specification, which suggests that the tear-off outwardly projecting section is "an area **40** of reduced section . . . to weaken the material and allow it to be torn off." '029 Patent, 2:59–60. According to Plaintiffs, because the '029 Patent contemplates differences between the tear-off section and the other aspects of the annular cover, it would be inappropriate to require that the annular cover be "uniform." *Pls.' Reply Br.* 2:26–3:18.

Besides taking issue with the "uniform" language in Defendant's proposed construction, in their papers, Plaintiffs do not meaningfully respond to Defendant's position that the annular cover should not be construed such that it is broad enough to include "multiple covers or a cover consisting of disparate and disconnected components." *Def.'s Responsive Br.* 5:19–20; *see also Pls.' Reply Br.* 2:26–3:4 (acknowledging the argument, but simply arguing that it is not reflected in Defendant's proposed construction). This, however, appears to be the real issue.

As Defendant notes, Claim 1 refers to "an annular cover" comprised of "portions," including an "inner portion" and a "top portion." *See generally* '029 Patent, Claim 1. Claim 1 further requires that the "top portion" include a "tear-off section." *Id.* The use of the terms "portions" and "section" suggests that the inner portion, top portion, and tear-off section are all part of the same cover structure. This is further supported by the portions of the patent specification already discussed, which relate to an embodiment showing all of these aspects

existing together as parts of a single structure. *See* '029 Patent, FIG. 1.

The Court notes that legal authority exists for the proposition that "an indefinite article 'a' or 'an' in patent parlance carries the meaning of 'one or more' in open-ended claims containing the transitional phrase 'comprising.'" *Baldwin Graphic Sys., Inc. v. Siebert, Inc.*, 512 F.3d 1338, 1342 (Fed. Cir. 2008) (quoting *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1356 (Fed. Cir. 2000)). "An exception to the general rule that 'a' or 'an' means more than one only arises where the language of the claims themselves, the specification, or the prosecution history necessitate a departure from the rule." *Id.* at 1342–43 (citing *Abtox Inc. v. Exitron Corp.*, 122 F.3d 1019 (Fed. Cir. 1997); *Insituform Techs., Inc. v. Cat Contracting, Inc.*, 99 F.3d 1098 (Fed. Cir. 1996)). After considering the intrinsic record in this case and the parties' arguments, the Court finds that the language of the claims themselves, particularly their use of the phrases "portion" and "section," necessitates departure from the "one or more" rule for the term "annular cover." Indeed, this is best appreciated by considering the "tear-off outwardly projecting section" limitation. The claims and the specification both make clear that this "tear-off section" is intended to be torn off from the rest of the cover. In other words, it would be inappropriate to construe the claims such that the "tear-off section" of the "top portion" of the "annular cover" could be considered some additional or separate component that is simply torn away from the outside of the device, but not otherwise connected to the rest of the annular cover.

At the hearing, Plaintiffs argued that "annular cover" should be construed to encapsulate a cover comprised of multiple separate and distinct pieces. Plaintiffs analogized the "annular cover" of the '029 Patent to the cover on a football stadium. Plaintiffs also argued that they did not believe the terms "sections" or "portions" necessarily suggest aspects of a single whole. In response to questioning regarding the "tear-off section," Plaintiffs similarly stated their position that they believed nothing in the patent suggests that the tear-off section must be limited to require that it be torn off from another part of the same structure of the cover. Having considered Plaintiffs' arguments, particularly as they relate to the "tear-off section," the Court finds them unpersuasive. The claims must be read in light of the specification, and Plaintiffs' interpretation of "annular cover" and "tear-off section" would impermissibly expand the meaning of those claim terms beyond what is contemplated by the patent disclosure.

For these reasons, the Court construes the term "annular cover" to mean "a single, ring-shaped cover including at least a top portion and an inner portion that are parts of the same structure." The term "a tear-off outwardly projecting section" is construed as "a section

initially formed as part of the same structure as the rest of the annular cover, which can be torn off from the rest of the annular cover."

c. "engage" (Claim 2) / "engaging" (Claim 1)

Plaintiffs' Proposed Construction	Defendant's Proposed Construction
Plain and ordinary meaning	"(to be) locked together with"

Claim 1 of the '029 Patent requires "an annular cover . . . having an inner portion extending downwardly and ***engaging*** an upper part of said inner wall of said body." '029 Patent, Claim 1 (emphasis added). Claim 2 of the '029 Patent requires that the inter-engagement means of Claim 1 "consist of annular lips on the inner walls of said cover to ***engage*** upper edges on said annular body." *Id.* Claim 2 (emphasis added). The parties dispute whether the terms "engage" / "engaging" require that components be locked together, as Defendant argues in its proposed construction, or can be understood by their plain and ordinary meaning, as Plaintiffs argue.

In its opposition brief, Defendant clarifies that by "locked," Defendant "simply means that there is an attachment that prevents the cover from freely falling off the body." *Def.'s Responsive Br.* 9:14–16. To further support its position, Defendant states, "[a]s in, a blanket draped over a cassette is not 'engaging' the cassette." *Id.* 9:16–18. Defendant agrees that "[t]he fact that components may be separated, namely by 'tearing off,' does not mean that they are not *initially* lockingly engaged." *Id.* 9:9–11 (emphasis in original).

> In response to Defendant's assertions, Plaintiffs state in part,
> [t]o be clear, it is not Edgewell's position that the term 'engage is satisfied by 'mere contact,' as Munchkin argues. Rather, Edgewell's position is that the plain meaning of 'engage' is readily understood in the context of the 029 Patent, and does not include the additional requirement that components be 'locked together.'

Pls.' Reply Br. 4:7–9. Plaintiffs state that the plain and ordinary meaning of "engaged" is something broader than "locked," but Plaintiffs do not provide an alternative description or definition for their understanding of the plain and ordinary meaning of the term in the context of the '029 Patent. *Id.* 5:3–4. Plaintiffs do, however, submit a dictionary definition where "engage with" is defined as "establish a meaningful contact or connection with," or "(of a part

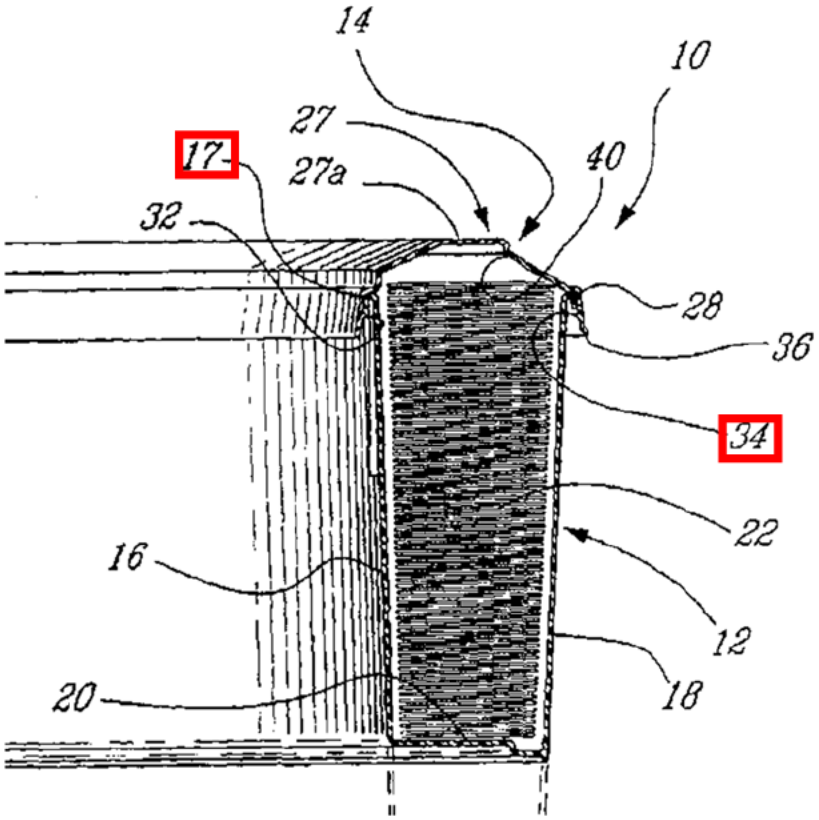
of a machine or engine) move into position so as to come into operation." *The New Oxford American Dictionary* (2001), Dkt. # 134-3 ("engage with"). Plaintiffs also do not appear to dispute Defendant's characterization of "engage" as requiring some form of "attachment." *Pls.' Reply Br.* 5:11–17 (acknowledging Defendant's argument, but discounting it by stating, "Munchkin's explanation does not clarify the already well-understood meaning of the term at issue (*i.e.*, 'engage,' not 'locked') and the simple fact that Munchkin must construe its own construction indicates that its proposal is ambiguous and should be rejected.").

As described, Defendant's proposed construction does not accurately reflect Defendant's position regarding the meaning of the term "engage." Moreover, Defendant's argument that the terms "engage" / "engaging" must be "synced" with the term "cooperating inter-engagement means," *see Def.s' Responsive Br.* 8:7–21, is confusing, unpersuasive, and apparently irrelevant, given Defendant's other assertions about its interpretation of the appropriate scope of the term "locked," *id.* 9:7–17. Although the Court is not particularly persuaded that claim construction of the term "engage" is necessary, in order to attempt to address this dispute, the Court construes the terms "engage" / "engaging" as "attach" / "attached to."

d. *"cooperating inter-engagement means . . . to lock said cover to said body" (Claim 1) / "said inter-engagement means" (Claim 2)*

Plaintiffs' Proposed Construction	Defendant's Proposed Construction
Structure: one or more lips or tongues on the cover that engage one or more edges or openings of the annular body and equivalents thereof Function: to lock the cover to the body	Function: locking the cover to the body Structure: '029 Patent, 2:48–56 ("The lower edge 30 of the downwardly extending portion 26 of the flange has an annular inner lip 32 that engages under the downturned edge 17 of the annular body 12. The annular body 12 and the cover 14 are lockingly engaged initially to one another (as seen on the left side of FIG. 1) by means of the cooperation of the inner lip 32 as described above and by an annular lip 34 adjacent edge 36 of section 28 which engages the upper downturned edge 37 of the annular body 12.")

Claim 1 requires "cooperating inter-engagement means on said upper part of said body and on opposite edges of said cover to lock said cover to said body." The parties agree that the "cooperating inter-engagement means" term is a means-plus-function term governed by § 112, ¶ 6. *See Def.'s Responsive Br.* 12:18–24; *Pls.' Reply Br.* 6:15–22. They also agree that the claimed function for this term is "to lock the cover to the body" (*i.e.*, "to lock said cover to said body"). *Def.'s Responsive Br.* 12:18–24; *Pls.' Opening Br.* 11:6–7. They also agree that one of the disclosed structures in the specification that corresponds to the claimed function is described at column 2, lines 48 through 56 of the '029 Patent specification. *Pls.' Opening Br.* 11:12–14. This portion of the patent specification describes the combination of (1) an inner lip **32** that "engages under the downturned edge **17** of the annular body **12**" and (2) an annular lip **34** that "engages the upper downturned edge **37** of the annular body **12**." '029 Patent, 2:48–56. This is apparently shown in Figure 1 of the '029 Patent:



'029 Patent, FIG. 1 (figure cropped and annotations added). Defendant refers to the

interlocking means described in the Figure 1 embodiment (the embodiment that it agrees represents corresponding structure for this term) as the "lips-and-edges" embodiment. *See, e.g.*, *Def.'s Responsive Br.* 13:4–5.

The parties' sole point of disagreement is whether one other embodiment disclosed in the specification also provides corresponding structure for this means-plus-function claim term. *Pls.' Opening Br.* 11:12 (listing relevant patent disclosure at '029 Patent, 2:1–6, 2:48–50, 2:51–56, 3:36–40). The disputed corresponding structure is generally described with reference to Figures 3 and 4. The specification describes that for the embodiments shown in these figures, "[t]he annular body **112** and the flange **114** are lockingly engaged to one another by means of the cooperation of a series of tongues **132** having a size and shape to snapingly engage info [sic] corresponding openings **134** on the inner wall of the annular body." '029 Patent, 3:36–40.

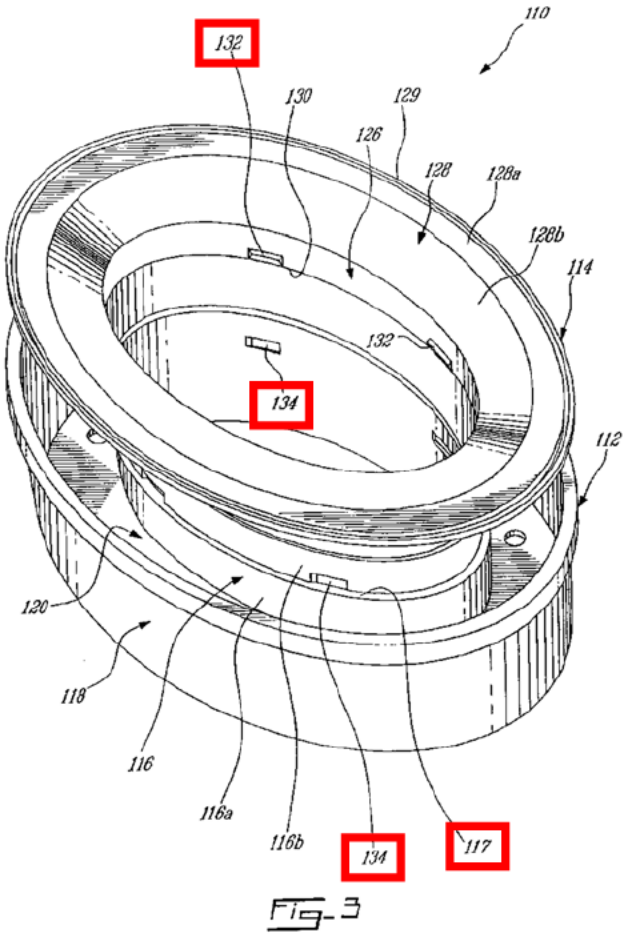


Fig. 3

Id., FIG. 3 (annotations added).

Notably, Defendant does not dispute that this is a "set[ ] of structures that correspond to the function of locking the cover of the cassette to the body." *Def.'s Responsive Br.* 13:3–10. Despite this admission, Defendant argues that this structure, which it refers to as the "tongues-and-openings" embodiment, should not be considered corresponding structure for Claim 1's "cooperating inter-engagement means" term. Defendant argues that corresponding structure should be limited to the lips-and-edges structure because the tongues-and-openings structure is disclosed in the patent specification as part of an "unclaimed" embodiment. *Def.'s Responsive Br.* 12:26–13:2, 13:7–10 ("The latter set (tongues and openings) appears in an embodiment that is not claimed.").

As Defendant notes, Figures 3 and 4 of the '029 Patent describe an embodiment that does not include a "tear-off outwardly projecting section." Defendant argues that the lack of a "tear-off outwardly projecting section" in the embodiment shown in Figures 3-4 creates a "key distinction over the claimed invention" relevant to the "cooperating inter-engagement means" term. *Def.'s Responsive Br.* 13:23–24. Defendant states,

> [t]his distinction is critical, because the structure in the unclaimed embodiment—tongues and openings—*would not function* in the claimed embodiment . . . . [G]iven the degree to which a tongues-and-openings structure would lock the cover to the body, this structure would prevent---or at least significantly inhibit—a user from being able to tear-off a section of the cover.

Id. 14:11–18 (emphasis in original). Defendant, however, does not provide any evidentiary support for these assertions. Indeed, as Plaintiffs note, "[n]owhere does the specification suggest that the tongue/opening combination is capable of locking the annular cover to the annular body to a greater degree than the lip/edge combination." *Pls.' Reply Br.* 7:28–8:2. At the hearing, Defendant suggested that the intrinsic record and the distinction between the two embodiments disclosed in the specification showed that the tongues-and-openings structure would not be *required* by an embodiment that relies on a tear-off section. This, however, is not the relevant inquiry, and Defendant has failed to persuasively explain why a tongues-and-openings structure must necessarily be excluded from an embodiment that also includes a tear-off section.

Defendant also notes that during patent prosecution, the Examiner issued a restriction

requirement[3] directing the applicant to elect claims related to either the species "shown in Figures 1-2" or the species "shown in Figures 3-4" of the '029 Patent application. *Patent Prosecution History for '029 Patent*, Dkt. # 136-7, 107 (Restriction Requirement mailed June 7, 2004). Defendant apparently presents this information to support its argument that Figures 3-4 depict an "unclaimed embodiment," implying that unique features only disclosed in the context of describing Figures 3-4 should thus be excluded from the scope of the claims. *Def.'s Responsive Br.* 13:11–22. However, for purposes of prosecution history disclaimer, "[t]he election of an invention in response to an ambiguous restriction requirement . . . cannot be said to provide any guidance forming a basis for narrowing a broadly drafted claim." *Plantronics, Inc. v. Aliph, Inc.*, 724 F.3d 1343, 1351 (Fed. Cir. 2013). Nothing in the Examiner's restriction requirement made any reference to the "cooperating inter-engagement means" limitation. Likewise, there is no suggestion from the cited portions of the prosecution history that the applicant intended (or was being required) to exclude the tongues-and-openings structure from the meaning of this term.

Defendant's "unclaimed embodiment" theory otherwise lacks any support in Defendant's cited cases, which simply refer to general principles of construing means-plus-function terms. *See Def.'s Responsive Br.* 15:6–13.

Indeed, Claim 2 of the '029 Patent recites, "said inter-engagement means consist of annular lips on the inner walls of said cover to engage upper edges on said annular body." *Id.* Claim 2. The doctrine of claim differentiation supports the conclusion that "inter-engagement means" as that term appears in Claim 1 should have a broader meaning than the lips-and-edges structure claimed in Claim 2. The doctrine of claim differentiation "is based on 'the common sense notion that different words or phrases used in separate claims are presumed to indicate that the claims have different meanings and scope.'" *Andersen Corp. v. Fiber Composites, LLC*, 474 F.3d 1361, 1369–70 (Fed. Cir. 2007) (citing *Karlin Tech. Inc. v. Surgical Dynamics, Inc.,* 177 F.3d 968, 971–72 (Fed. Cir. 1999)). "To the extent that the absence of such difference in meaning and scope would make a claim superfluous, the doctrine of claim differentiation states the presumption that the difference between claims is significant." *Id.* (quotation omitted). In this case, if "inter-engagement means" was construed such that the only corresponding structure was the lips-and-edges structure, Claim 2 would be rendered

[3] An Examiner may issue a "restriction requirement" during patent prosecution when s/he believes "two or more independent and distinct inventions are claimed in one application." 35 U.S.C. § 121.

superfluous because it would have effectively the same claim scope as Claim 1. The doctrine of claim differentiation thus supports the conclusion that the "inter-engagement means" term in Claim 1 covers more than just the lips-and-edges structure. Defendant does not meaningfully rebut the presumption presented by claim differentiation in this case, and the Court finds that it supports the conclusion that the tongues-and-openings structure is also properly found to correspond to the claimed "cooperating inter-engagement means" term.

Because Defendant has conceded that the tongues-and-openings structure is a "structure[ ] that correspond[s] to the function of locking the cover of the cassette to the body," *Def.'s Responsive Br.* 13:3–4, and has failed to provide a persuasive basis as to why the structure must nonetheless be excluded from the meaning of the "cooperating inter-engagement means" term, the Court construes the term "cooperating inter-engagement means" as follows:

> [Governed by § 112, ¶ 6]
> Function: to lock the cover to the body
>
> Structure: one or more lips or tongues on the cover that engage one or more edges or openings of the annular body and equivalents thereof. '029 Patent, 2:1–6, 2:48–50, 2:51–56, 3:36–40.

e. "on opposite edges of said cover" (Claim 1)

Plaintiffs' Proposed Construction	Defendant's Proposed Construction
Plain and ordinary meaning	"on the inner edge and outer edge of said cover"

Claim 1 states, *inter alia*,

> 1. A cassette for use in dispensing a pleated tubing comprising:
> an annular body . . . ;
> an annular cover . . . ; and
> ***cooperating inter-engagement means*** on said upper part of said body ***and on opposite edges of said cover*** to lock said cover to said body.

'029 Patent, Claim 1 (emphasis added). Plaintiffs argue that "[t]he term ['on opposite edges of

said cover'] requires nothing more than that the inter-engagement means on the cover be opposite the inter-engagement means on the upper part of the body." *Pls.' Opening Br.* 13:8–10; *see also id.* 14:18–21 (Plaintiffs alternatively proposing that the term be construed as "on corresponding edges of said cover"). Defendant argues that "'opposite' modifies 'edges of said cover,' such that the cooperating inter-engagement means are located on the inner edge and outer edge of the cover." *Def.'s Responsive Br.* 16:7–9.

As previously explained, Claim 2 of the '029 Patent requires that "said inter-engagement means ***consist of*** annular lips on the inner walls of said cover to engage upper edges on said annular body." '029 Patent, Claim 2 (emphasis added). It is important that Claim 2 relies on the transitional phrase "consist of." In patent law parlance, the transitional term "comprising" is considered open-ended: the claims cover what is explicitly recited, but are also understood to cover something more. The transitional term "consisting" is not open-ended: the claims only cover what is recited. Claim 2 requires that "inter-engagement means" are ***only*** annular lips on the inner walls of said cover to engage upper edges on said annular body. Claim 2 makes no mention of a requirement that there are additional inter-engagement means on the annular cover that are located, for instance, on the outer walls, *i.e.* outer edges, of the cover. For this reason, Defendant's interpretation of the phrase "on opposite edges of said cover" is inconsistent with the claim language, particularly the requirements of Claim 2.

At the hearing, Defendant emphasized language of Claim 1 requiring that "said cover hav[e] ***an inner portion extending downwardly and engaging an upper part of said inner wall of said body*** and a top portion extending over said housing; said top portion including ***a tear-off outwardly projecting section having an outer edge engaging an upper part of said outer wall of said annular body***." '029 Patent, Claim 1 (emphasis added). Defendant argued that this language, and particularly the claim's use of the term "engaging," must be interpreted as being related to the "cooperating inter-engagement means" limitation. Based on this assumption, Defendant further argued that the "cooperating inter-engagement means" must be present on both the inner and outer walls of the body, such that they correspond to the "inner portion" and "outer edge" of the cover that engage the inner and outer walls of the body. This argument, however, fails to take into account Claim 2, which precludes such an interpretation and instead suggests that the cover may engage the body without necessarily "locking" to the body as a cooperating inter-engagement means. It would also appear to render certain language in the claims superfluous.

Although the Court is not particularly persuaded that claim construction is necessary for

this term, to avoid any ambiguity, it construes the phrase "on opposite edges of said cover" consistent with Plaintiffs' alternative proposed construction as "on corresponding edges of said cover."

ii. '420 Patent Terms

a. "clearance" (Claims 1–3, 5–8, 10–13, 16–17)

Plaintiffs' Proposed Construction	Defendant's Proposed Construction
"a portion of the central opening of the annular receptacle that is complementary to a corresponding structure of the pail"	Ordinary meaning/defined in the claim(s)

Claim 11 of the '420 Patent includes the disputed term "clearance" and is instructive in considering the parties' dispute. It states,

> 11. A cassette for packing at least one disposable object, comprising:
> an annular receptacle including an annular wall delimiting a central opening of the annular receptacle, a bottom wall at a bottom end of the cassette, and a volume receiving an elongated tube of flexible material radially outward of the annular wall, ***the annular receptacle including a clearance defined by a portion of the annular wall extending obliquely upward from a junction with the bottom wall, said portion of the annular wall joining with an upright portion of the annular wall whereby the clearance opens into the central opening***;
> a length of the elongated tube of flexible material disposed in an accumulated condition in the volume of the annular receptacle; and
> an annular opening at an upper end of the annular receptacle for dispensing the tubing such that the elongated tube extends through the central opening of the annular receptacle to receive disposable objects in an end of the elongated tube,
> wherein at least a portion of the volume of the annular receptacle is located radially outward of and side by side with at least a portion of the clearance such that at least a portion of the elongated tube of

> flexible material is disposed in the accumulated condition in said portion of the annular receptacle.

'420 Patent, Claim 11 (emphasis added).

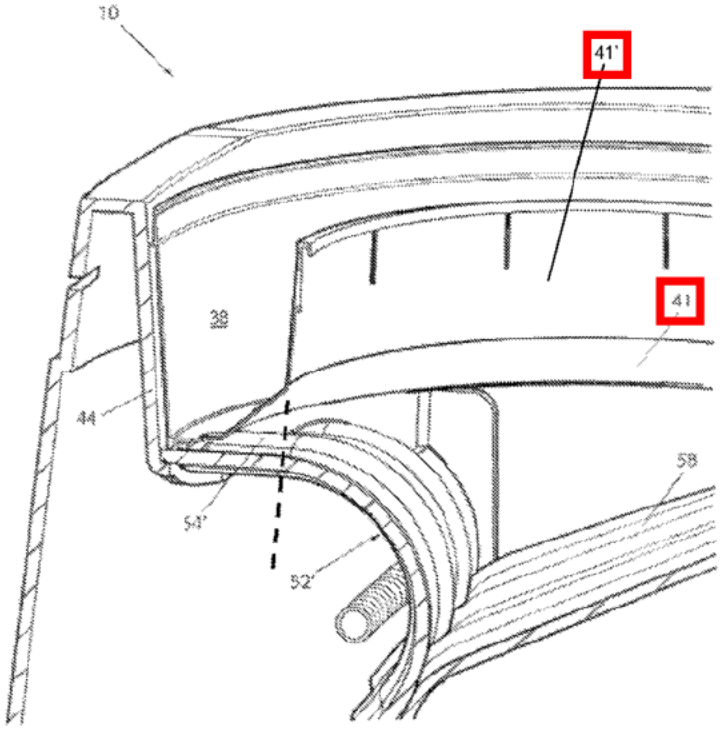
The parties disagree about whether "clearance" is a term that itself connotes structure or instead is used to describe a non-structural portion of the opening inside the claimed cassette. The language in many of the claims is ambiguous as to this issue. For the most part, as Plaintiffs observe, the claims describe the clearance "in terms of (i) where it is located and (ii) the impact of the clearance on the volume of the annular receptacle." *Pls.' Opening Br.* 19:24–26. Through their competing positions, the parties show that language in Claim 1, for instance, can support opposite interpretations about the nature of the claimed "clearance." *Compare, e.g., Pls.' Opening Br.* 21:19–24 *with Def.'s Responsive Br.* 19:3–21. Claim 11 provides a bit more guidance. It refers to "a clearance ***defined by*** a portion of the annular wall" and specifically describes that annular wall as "extending obliquely upward from a junction with the bottom wall." '420 Patent, Claim 1 (emphasis added). Moreover, Claim 11 describes that the clearance "opens into the central opening." This language supports the conclusion that a clearance is not the walls itself, but the space adjacent to the relevant walls.

In addition, Claim 12 states, "the clearance in the cassette ***has the shape of a chamfer***." '420 Patent, Claim 12 (emphasis added). In general, this claim language supports Plaintiffs' position. Rather than simply state that the clearance ***is*** a chamfer, Claim 12 requires that the clearance have "***the shape of*** a chamfer." Defendant interprets this language to mean that the clearance must include the wall itself because, Defendant asserts, the actual shape of the space surrounded by the relevant portions of the wall is triangular. *Def.'s Responsive Br.* 135:17–19 ("If the space adjacent to the beveled wall has any 'shape' at all, it is a triangle, defined by the beveled wall of the cassette and linear projections of the bottom and inner walls."). The Court does not find Defendant's position particularly persuasive, especially when considered in combination with the language of Claim 11, the disclosure in the specification, and the actual physical configuration of the space adjacent to the chamfered portions of the annular wall that are depicted in some of the disclosed embodiments.

> In describing one embodiment, the '420 Patent specification explains, [t]he receptacle **38** of the cassette **30** defines a chamfer clearance **41** at a bottom of the central opening **34**. The chamfer clearance **41** extends continuously from an annular wall **41'** of the receptacle **38** (see FIG. **6**) and is provided in order to

> ensure that the cassette **30** is properly installed in the holder **26** when the apparatus **10** is in use.

'420 Patent, 5:10–15. Thus, again, the specification refers to ***defining*** a clearance. Figure 6 depicts the chamfer clearance **41** "extend[ing] . . . from" the annular wall:



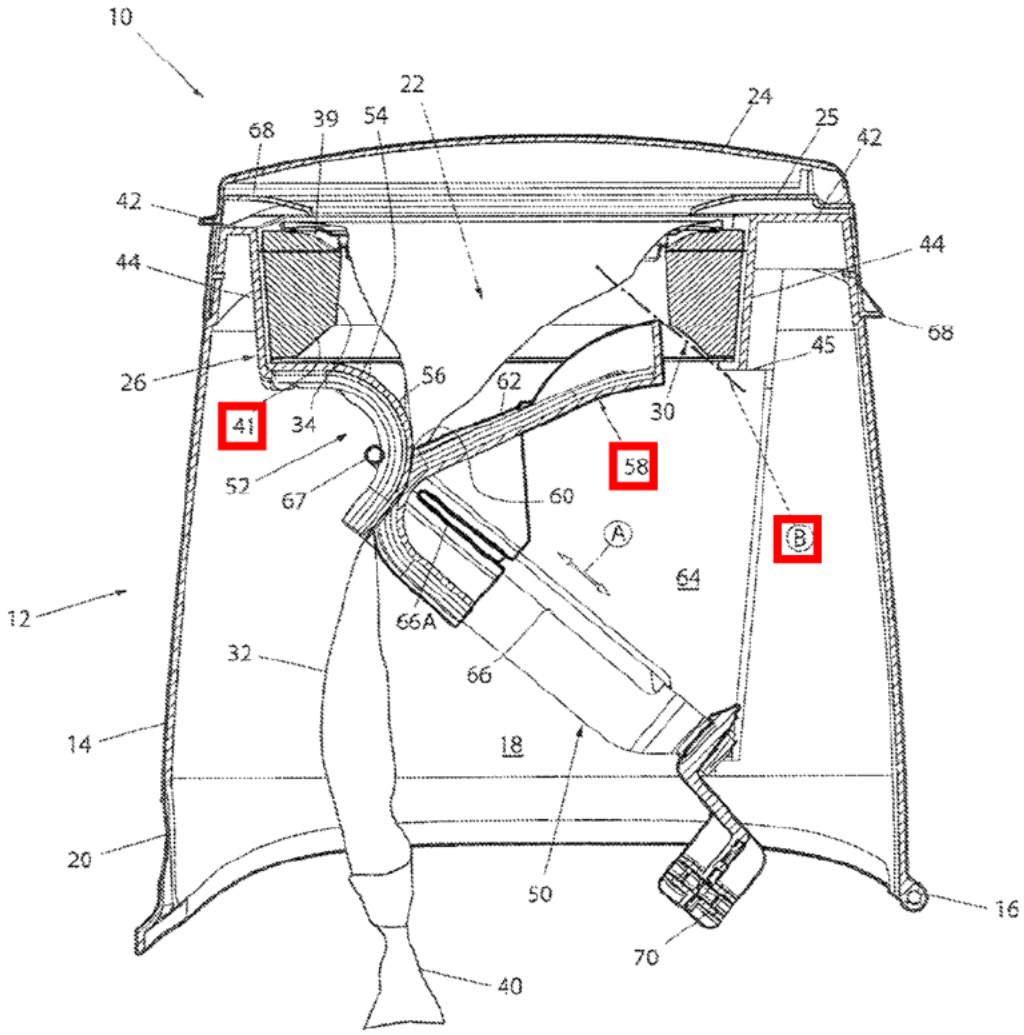
Id., FIG. 6 (annotations added). Defendant argues that Figure 6 and other figures in the '420 Patent support its position that the clearance is structural. According to Defendant, label 41 is pointing to the wall itself rather than the space next to the wall. *Def.'s Responsive Br.* 19:23–25. The '420 Patent's two-dimensional patent figures fail to provide images with the three-dimensional depth perception that would be necessary to conclusively support Defendant's position. Although Defendant raises a unique point (that goes unrebutted by Plaintiff), it is not sufficient to rebut the language of Claim 11 and the written portions of the specification discussed in this Order.

> The specification later explains, in describing the same embodiment, that the cassette

includes a closing mechanism **50** with a "movable portion" **58**. *Id.* 5:27–30 (explaining that the closing mechanism **50** provides access to the flexible tubing **32** and "prevent[s] odors from escaping from the flexible tubing **32**."), 5:53–6:3 (describing the movable portion **58** of the closing mechanism **50**). According to the specification,

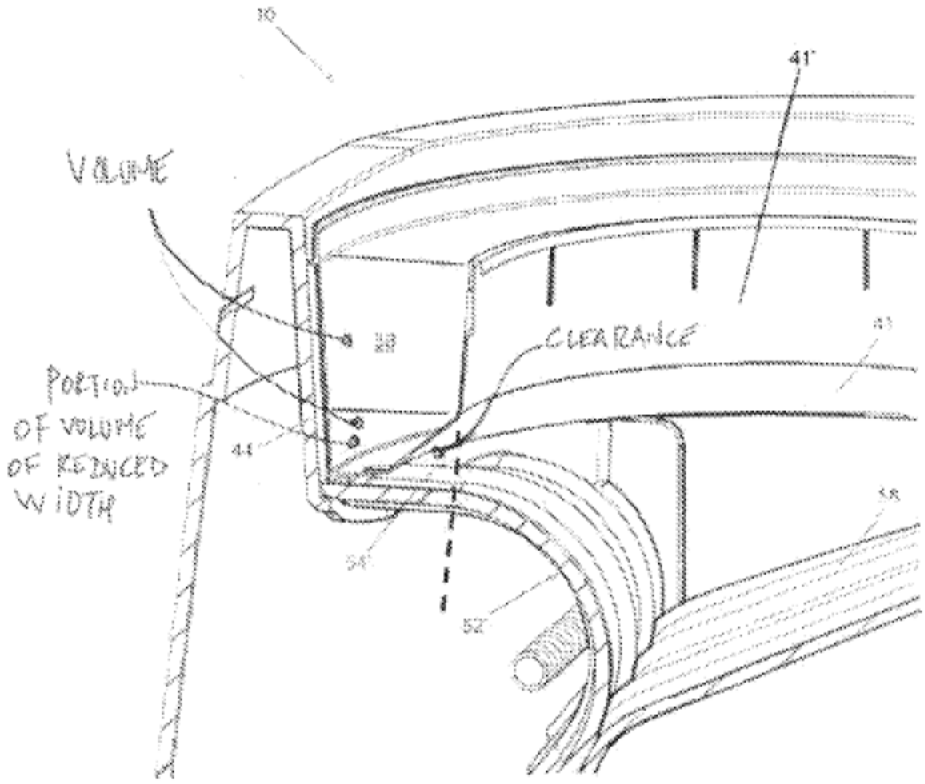
> [a] path of movement of the movable portion **58** is illustrated at B. It is observed that the movable portion **58** passes closely ***to the wall defining the chamfer clearance 41***. If the chamfer clearance **41** were not provided, the cassette **30** would impede the movement of the movable portion **58**.

Id. 6:35–40 (emphasis added). In other words, the specification again places emphasis on a wall "defining" a clearance. This language again supports that the clearance is the adjacent space, not the wall itself. The concepts described by this disclosure are depicted in Figure 1:



Id., FIG. 1. Importantly, as explained by the specification, the purpose of the clearance is to allow the closing mechanism **58** of the device to properly function by creating space for this mechanism to move through. As the Court mentioned at the hearing, this calls to mind other everyday uses of the term "clearance," such as the bar hanging from the ceiling of a parking structure listing the "clearance" at a certain amount of space above the ground. The specification's language in referencing and describing the clearance further supports the conclusion that the clearance is a non-structural space within the cassette.

Defendant also heavily emphasizes language in the prosecution history to support its argument that the clearance is structural. *Def.'s Responsive Br.* 20:1–8. Plaintiffs fail to respond to Defendant's arguments regarding the prosecution history, either in the papers or at the hearing. In distinguishing prior art during patent prosecution, the patent applicant stated, "[a]s discussed above, amended claim 1 essentially requires that a portion of a volume of the annular receptacle has a reduced width relative to another portion as a result ***of the structure of the clearance***." *Patent Prosecution History for '029 Patent*, Dkt. # 136-8, 117 (Office Action Response mailed July 23, 2014) (emphasis added). But this language is not as clear and unambiguous as Defendant asserts. In this context, the patent applicant could simply be using the word "structure" to refer to the ***shape*** created by the clearance. Indeed, in otherwise distinguishing the prior art, the patent applicant emphasized how the '420 Patent's clearance's relationship to the neighboring volume (where the tubing is housed) creates a distribution of space that is not disclosed in the prior art. *See id.* 115–177. Notably, in the same filing with the patent office, the patent applicant also included a version of Figure 6 of the '420 Patent with additional handwritten annotations:



Id. 115. Again bearing in mind the difficulties of evaluating depth perception in these two-dimensional figures, the dot hand-labeled "clearance" by the patent applicant does not appear to be pointing to the surrounding wall, but to the space in front of it. Ultimately, the prosecution history is at least ambiguous, if not supportive of the conclusion that a "clearance" is not necessarily structural.

Although considered extrinsic evidence that is entitled to less weight, contrary to Defendant's objection, it is also still relevant that a technically-savvy panel of the Patent Trial and Appeal Board ("PTAB"), in denying institution of *inter partes* review as to claims of the '420 Patent, found that "a 'clearance' is ***an area*** that is provided to ensure that cassette 30 is properly installed within holder 26 when apparatus 10 is in use and is positioned to permit the movement of movable portion 58 adjacent cassette 30." IPR2015-0050, Paper 7 at 7 (April 3, 2017 decision denying institution of *inter partes* review) (emphasis added). The PTAB went on to state, "consistent with the Specification of the '420 patent, a 'clearance' is a component that is configured to permit [sic] one structure from interference with another structure." *Id.* Defendant specifically takes some issue with the PTAB's statements, observing that the PTAB uses the word "component" in its construction of "clearance." However, in the context of the PTAB's other statements, the PTAB's decision shows that the PTAB interpreted the clearance as used in the '420 Patent as referring to space instead of structure. Ultimately, the PTAB's determination that the clearance is an "area" is consistent with the understanding Court's interpretation of the intrinsic record as referring to the clearance as a space, not a structure.

Although a close call given the many ambiguous aspects of the record, the Court is ultimately persuaded that the weight of the intrinsic record supports Plaintiffs' interpretation of the term "clearance," to the extent Plaintiffs argue that a "clearance" is non-structural space. Plaintiffs' argument that the "clearance" is "a portion of the central opening," however, faces some inconsistencies compared to the record. For instance, Claim 11 refers to the clearance "opening ***into***" the central opening. The Court also notes that the term "pail" does not appear in the '420 Patent claims. Plaintiffs' proposed construction would also be inappropriate because it introduces this wholly new term without sufficient context or definition. Thus, rather than adopt Plaintiffs' proposed construction, the Court construes the term "clearance" as "a space within the annular receptacle that is configured to prevent interference between the annular wall and another structure." Other explicit language defines the scope of the term "clearance" in the claims, particularly its relationship to the neighboring annular wall, and the Court finds it unnecessary to repeat that language or otherwise characterize the clearance in a construction that goes beyond the claim language.

b. "extend[ing] continuously" (Claims 1, 5, 10, and 16)

Plaintiffs' Proposed Construction	Defendant's Proposed Construction
Plain and ordinary meaning	"extend/extending without break or interruption"

The parties dispute whether the phrase "extending continuously" requires that the clearance extend continuously "from ***a*** point on the annular wall," *Pls.' Reply Br.* 11:9 (emphasis added), or must extend continuously "from ***all*** points on the annular wall," *Def.'s Responsive Br.* 22:13 (emphasis added).

Claim 1 of the '420 Patent requires "the clearance extending continuously from the annular wall and radially outward of a downward projection of the annular wall." '420 Patent, Claim 1. As Plaintiffs observed at the hearing, Claim 3 of the '420 Patent requires that "the clearance extends on the full periphery of the central opening." *Id.* Claim 3. The doctrine of claim differentiation thus supports the conclusion that a clearance can "extend[ ] continuously" as required by Claim 1 without "extend[ing] on the full periphery." Otherwise, Claim 3 would be rendered redundant/superfluous.

Likewise, as Plaintiffs observe, the patent specification explains that "[t]he chamfer clearance **41** extends continuously from an annular wall **41'** of the receptacle **38** . . . The chamfer clearance **41** is provided on the full periphery of the cassette **30**, but may also be partial (i.e., not on the full periphery of the central opening of the cassette)." '420 Patent, 5:12–19.

Together, the claim language and specification support the conclusion that the phrase "extend[ing] continuously" as used in Claim 1 of the '420 Patent does not require extension on the full periphery. Instead, the record supports the conclusion that the claim uses the phrase "extend[ing] continuously" in describing the clearance's extension "radially outward" from a particular point on the wall. Defendant's interpretation of the claims and proposed construction is rejected. In order to avoid confusion that might be created by simply construing the phrase according to its plain and ordinary meaning, the Court construes "extend[ing] continuously" to mean "extend[ing] continuously from at least one point."

c. "annular opening" Claim Terms

Claim Term	Plaintiffs' Proposed Construction	Defendant's Proposed Construction
"an annular opening at an upper end of the cassette for dispensing the elongated tube such that the elongated tube extends through the central opening of the annular receptacle to receive disposable objects in an end of the elongated tube" ('420 Patent, Claim 1)	Plain and ordinary meaning	"an annular opening at an upper end of the cassette, the elongated tube dispensing through the annular opening and extending through the central opening of the annular receptacle to receive disposable objects in an end of the elongated tube"
"an annular opening at an upper end of the annular receptacle for dispensing the tubing such that the elongated tube extends through the central opening of the annular receptacle to receive disposable objects in an end of the elongated tube" ('420 Patent, Claims 6, 11)	Plain and ordinary meaning	"an annular opening at an upper end of the annular receptacle, the elongated tube dispensing through the annular opening and extending through the central opening of the annular receptacle to receive disposable objects in an end of the elongated tube"

The parties dispute whether the "annular opening" claim phrases in the '420 Patent refer to the function of the annular opening (*i.e.*, that the annular opening is *capable of* dispensing tubing) or additional structural requirements of the annular opening (*i.e.*, that the tubing *must always* extend through the central opening). Specifically, the claims refer to "an annular opening . . . ***for dispensing*** . . . ***such that*** the elongated tube extends through the central opening." Plaintiffs focus on the phrase "for dispensing" to support their position that dispensing tubing is a capability of the annular opening. Defendant focuses on the phrase "such that" to support its competing argument that for the claim language to be satisfied, tubing must at all times be dispensed through the annular opening.

Defendant's position, which would effectively read the phrase "for dispensing" out of the claims, is not supported by a single citation to legal authority. Indeed, Defendant does not even address the phrase "***for*** dispensing" in making its arguments. Nor is the Court aware of legal authority that would support Defendant's position. Defendant asserts, without support, that if the claim phrase is interpreted as merely describing a capability of the annular cover, "it has no meaning." *Def.'s Responsive Br.* 23:28. Defendants' argument is not fully developed and is not persuasive. The specific language of the claims, and particularly the phrase "for dispensing" supports the conclusion that the disputed claim limitations are drawn to reciting a capability as opposed to an actual operation. *See Finjan, Inc. v. Secure Computing Corp.*, 626 F.3d 1197, 1204–05 (Fed. Cir. 2010) ("In this case, Finjan's non-method claims describe capabilities without requiring that any software components be 'active' or 'enabled.' The system claims recite software components with specific purposes: 'a logical engine *for preventing* execution', 'a communications engine *for obtaining* a Downloadable', or 'a linking engine . . . *for forming* a sandbox package'." (citations omitted and emphases in original)). The parties did not present oral argument relating to this term at the hearing.

With this caveat, the Court finds that no construction is necessary for the "annular opening" terms in the '420 Patent.

IV. Conclusion

The parties' disputed claim terms are **CONSTRUED** as follows:

Term (Patent No., Claim No(s).)	Court's Construction
"annular cover extending over said housing; said cover having an inner portion . . . and a top portion" ('029 Patent, Claims 1, 2, 4)	"annular cover" is construed as "a single, ring-shaped cover including at least a top portion and an inner portion that are parts of the same structure"
"engage" ('029 Patent, Claim 2) / "engaging" ('029 Patent, Claim 1)	"attach" / "attached to"
"said top portion including a tear-off outwardly projecting section" ('029 Patent, Claim 1)	"a tear-off outwardly projecting section" is construed as "a section initially formed as part of the same structure as

	the rest of the annular cover, which can be torn off from the rest of the annular cover"
"cooperating inter-engagement means . . . to lock said cover to said body" ('029 Patent, Claims 1, 2)	[Governed by § 112, ¶ 6] Function: to lock the cover to the body Structure: one or more lips or tongues on the cover that engage one or more edges or openings of the annular body and equivalents thereof ('029 Patent, 2:1–6, 2:48–50, 2:51–56, 3:36–40)
"on opposite edges of said cover" ('029 Patent, Claim 1)	"on corresponding edges of said cover."
"clearance" ('420 Patent, Claims 1–3, 5–8, 10–13, 16–17)	"a space within the annular receptacle that is configured to prevent interference between the annular wall and another structure"
"extend[ing] continuously" ('420 Patent, Claims 1, 5, 20, 16)	"extend[ing] continuously from at least one point."
"an annular opening at an upper end of the cassette for dispensing the elongated tube such that the elongated tube extends through the central opening of the annular receptacle to receive disposable objects in an end of the elongated tube" ('420 Patent, Claim 1)	No construction ("for dispensing" is a limitation describing capability and not actual operation)
"an annular opening at an upper end of the annular receptacle for dispensing the	No construction ("for dispensing" is a limitation describing capability and not

tubing such that the elongated tube extends through the central opening of the annular receptacle to receive disposable objects in an end of the elongated tube" ('420 Patent, Claims 6, 11)	actual operation)

IT IS SO ORDERED.